

REMARKS

This is in full and timely response to the final Office Action dated February 22, 2006. The present Amendment amends claims 3 and 4 and cancels claims 5 and 7 in order to further clarify a portion of the scope sought to be patented, and otherwise disputes certain findings of fact made in connection with the rejection of the claims. Support for these amendments can be found variously throughout the specification, including, for example, original claims 5 and 7. No new matter has been added.

Entry of this Amendment is proper under 37 C.F.R. §1.116 since the amendment: (a) places the application in condition for allowance (for the reasons discussed herein); (b) does not raise any new issues requiring further search and/or consideration; (c) satisfies a requirement of form asserted in the previous Office Action; and (d) places the application in better form for appeal, should an appeal be necessary. The amendment is necessary and was not earlier presented because it is made in response to arguments raised in the final rejection.

Accordingly, claims 3, 4, 6, and 8 are presently pending in the application, each of which is believed to be in condition for allowance. Reexamination and reconsideration in light of the present Amendment and the following remarks are respectfully requested. In view of this response, the Applicants believe that all pending claims are in condition for allowance. Reexamination and reconsideration in light of the above amendments and the following remarks are respectfully requested.

Rule 1.132 Declaration

The Applicants have submitted an executed Declaration under 37 C.F.R. § 1.132 in support of the arguments herein below. A clean, unsigned copy of the Declaration has also been submitted in order to visually supplement the signed Declaration.

Rejection under 35 U.S.C. §103

In the Action, claims 3, 4, 6, and 8 are rejected under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent No. 6,706,801 to Blum et al (“Blum”). This rejection is respectfully traversed.

Claims 3 and 4 are presently amended to recite, *inter alia*, a coating composition wherein the ratio of isocyanate group in the (D) component to 1 equivalent of hydroxyl group in the (A) component is **from 2.2 equivalents to less than or equal to 4.0 equivalents**.

In contrast, Blum does not disclose, teach, or even suggest a ratio of isocyanate group to 1 equivalent of hydroxyl group which lies in the range of from **2.2 equivalents to 4.0 equivalents**.

In order to demonstrate the unexpected and superior results obtained by the composition as recited in claims 3 and 4, the Applicant has submitted a Declaration under 37 C.F.R. § 1.132. The Declaration shows the criticality of the presently claimed ratio of 2.2 or higher. From the Experiments presented in the Declaration, it is clearly shown that Test Coated Plate (I), having an equivalent ratio of 2.2 NCO/OH (which is within the scope of the claimed invention), exhibited **unexpected and superior results in both coating performance and substrate shielding ability** in comparison with Test Coated Plate (II) having an equivalent ratio of 2.0 NCO/OH as disclosed by Blum.

It is well established that a showing of superior and unexpected properties can rebut a *prima facie* case of obviousness. *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963). The Federal Circuit Courts have stated that “Evidence that a compound is unexpectedly superior in one of a spectrum of common properties . . . can be enough to rebut a *prima facie* case of obviousness.” *In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987) (*Evidence showing that the claimed herbicidal compound was more effective than the closest prior art compound in controlling quackgrass and yellow nutsedge weeds in corn and soybean crops was sufficient to overcome the rejection under 35 U.S.C. 103, even though the specification indicated the claimed compound was an average performer on crops other than corn and soybean*).

Accordingly, because Blum fails to disclose, teach or suggest each and every limitation of claim 3 and 4, a *prima facie* case of obviousness has not been established, and withdrawal of this rejection is respectfully requested. *See, e.g., In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *accord.* MPEP 2143.03.

Claims 6 and 8 depend from claims 3 and 4. By virtue of this dependency, Applicant submits that claims 6 and 8 are allowable for at least the same reasons given above with respect to claims 3 and 4. In addition, Applicant submits that claims 6 and 8 are further distinguished

over *Blum* by the additional elements recited therein, and particularly with respect to each claimed combination. Applicant respectfully requests, therefore, that the rejection of claims 6 and 8 under 35 U.S.C. § 103(a) be withdrawn, and these claims be allowed.

CONCLUSION

For the foregoing reasons, claims 3, 4, 6, and 8 are allowable, and the present application is in condition for allowance. Accordingly, favorable reexamination and reconsideration of the application in light of the above remarks and the Declaration under 37 C.F.R. § 1.132 is courteously solicited. If the Examiner has any comments or suggestions that would place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number below.

Applicant believes no additional fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. KPC-294 from which the undersigned is authorized to draw.

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Respectfully submitted,

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